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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/125,700	10/23/1998	THOMAS FUHRMANN	200-008181-U	8084

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EXAMINER

HONG, HARRY S

ART UNIT PAPER NUMBER

2614

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/125,700	Applicant(s) FUHRMANN ET AL.	
	Examiner Harry S. Hong	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13 and 15-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9, 11-13 and 15-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 October 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to under 35 U.S.C. 132(a) because it has been amended (amendments filed on 10/9/02 and 2/20/02) to include new matter. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is: new Fig. 6 and its description. Fig. 6 and its description were added to introduce a new "third embodiment".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. Claims 1 – 9, 11-13 and 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification contains 2 embodiments; the first embodiment represented by Figs. 1 – 4 and their description, and the second embodiment represented by Fig. 5 and its description. See for example, page 4 of the specification which refers to "a first embodiment", "a second embodiment" and "two embodiments". The original specification has no reference to a third embodiment.

Figs. 1 - 4 and the description of the first embodiment are directed to the press-on/catch closure (element 11, Fig. 1) which makes cover 14 (Fig. 1) "releasably

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attached" to the bottom 2, and are not concerned with any specific components or any specific arrangements for the electronic circuitry inside the telephone. It is inherent that the telephone has some electronic circuitry, but again, the invention in the first embodiment is not drawn to any specific arrangement or components.

It is the second embodiment (Fig. 5) that is drawn to the specific arrangement of specific components inside the telephone.

That is, the first embodiment (Figs. 1-4) is drawn an external releasable press-on/catch closure while the second embodiment (Fig. 5) is drawn to the internal components of the telephone. In the second embodiment, the external covers of the telephone are attached via screws 43 (not press on/catch closure)¹

Also, one must note that the top cover in the first embodiment (see Figs. 1 and 2) is different from the top cover in the second embodiment (see Fig. 5). The buttons, display, shape ... etc do not match. Furthermore, it is also noted the covers and common elements between Fig. 1 and Fig. 5 have been given different reference numerals. Normally, if the same exact element is used in another figure, the same reference numeral is used in the different figures, and hence the use of different reference numerals has, at least, the appearance that applicant intended the parts in Fig. 1 and Fig. 5 to be different.

Claim 1 recites limitations about the external first and second housing (2 and 14, Fig. 1) being "**releasably attachable**" by the use of the "**press on/catch closure** [11, Fig. 1]" to modify the "external appearance" of the telephone (features from the 1st

embodiment) and also recites limitations about the "**retaining means** [35, Fig. 5]

Including said **key sensor** [29a, Fig. 5] but excluding said **key unit** [24, Fig. 5] (features from the 2nd embodiment).

Independent claims 15, 16 and 17 recite the same or similar features.

Thus, the claims are directed to a combination of features from the first embodiment and the second embodiment that lacks support in the specification.

The specification simply provides a generic and broad statement (page 10, 2nd paragraph) which states that:

"The present invention may include any novel feature or combination of features disclosed herein either explicitly or implicitly or any generalisation thereof"

It is believed that the above statement, which may refer to an infinite number of possible combinations of features, does not provide enablement. Again, the "mixing and matching" of features from two separate embodiments is not supported by the original specification. While the original specification does not intermix the two embodiments, it appears that applicant attempted to do just that in the appeal brief filed 4/10/04. The examiner's response to the "summary of the invention" (examiner's answer, 6/30/04, page 4) is hereby incorporated by reference. In it, the examiner, in part, clearly states that the key unit 8 in Fig. 1 of the first embodiment is fixed to the first housing 2,3 while the key unit 24 in Fig. 5 of the second embodiment is not fixed to housing 18.

¹ The press on/catch closure is used to make it easy and convenient for users to release the cover (14, *

Claim Rejections - 35 USC § 103

3. Claims 1-9, 11, 12, and 15 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (U.S. Patent 5,722,055) in view of Semenik et al (U.S. Patent 5,233,506).

This rejection has been provided in the Final office action (8/27/03) and in the Examiner's Answer (6/30/04) and is hereby incorporated by reference.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (U.S. Patent 5,722,055) in view of Semenik et al (U.S. Patent 5,233,506), as discussed above, and further in view of Takagi (U.S. Patent 5,235,636).

This rejection has been provided in the Final office action (8/27/03) and in the Examiner's Answer (6/30/04) and is hereby incorporated by reference.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

6. Applicant's arguments filed April 27, 2006 have been fully considered but they are not persuasive.

With respect to the objection to the specification, it was procedurally incorrect to deny entry of the Fig. 6 and its description. It should have been objected, as was and is done in the previous (2/10/06) and the present Office Actions respectively. The applicants are kindly asked to take the appropriate step(s) to address the objection.

With respect to the rejection under 35 U.S.C. 112, first paragraph, the examiner has reconsidered the appellants' arguments contained in the Appeal Brief of April 1, 2004 but is maintaining the rejection in order to proceed back to the appeal process.

With respect to the applicants' arguments concerning rejections under 35 U.S.C 103(a) over Kobayashi et al. (US 5,722,055) in view of Semenik et al. (US 5,233,506) and Kobayashi et al. (US 5,722,055) in view of Semenik et al. (US 5,233,506) and further in view of Takagi (US 5,235,636), "43" in Kobayashi et al. does read on the applicants' claimed cover of applicants' claimed retaining means because it plainly shows holding the key sensor (electronic components) but not the key unit; the key unit goes on top of the cover "43" (see FIGs. 1 and 5).

Also, although the recitation of Semenik et al. at column 7, lines 5-10 might address preventing disengagement, the "snap-lock" connections of Semenik et al. still read on the press-on/catch closure of the claimed invention. It can be argued that the

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press-on/catch closure of the claimed invention also prevents accidental disengagement. In response to applicants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to the rest of applicants' arguments, refer to the remarks on pages 23 and 24 in the Examiner's Answer (6/30/04).

Thus claims 1-9, 11-13, and 15-17 remain rejected.

Terminal Disclaimer

7. The terminal disclaimer filed on January 30, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,347,218 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry S. Hong whose telephone number is (571) 272-7485. The examiner is normally off on Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing F. Chan can be reached on (571) 272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harry S. Hong

Harry S. Hong
Primary Examiner
Art Unit 2614

July 20, 2006